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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,131	12/28/2001	Robert A. Dunstan	10559-549001	1605
20985 7590 09/04/2007 FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LEMMER, SAMSON B	
			ART UNIT 2132	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/034,131	<b>Applicant(s)</b> DUNSTAN ET AL.	
	<b>Examiner</b> Samson B. Lemma	<b>Art Unit</b> 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2132

### ***DETAILED ACTION***

1. **Claims 1-30** are pending/examined.

#### ***Priority***

2. This application does not claim priority of an application. Therefore, the effective filing data for the subject matter defined in the pending claims of this application is **12/28/2001**.

### ***Response to Arguments***

3. In view of the Appeal Brief filed on February 20, 2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR **1.111** (if this Office action is non-final) or a reply under 37 CFR **1.113** (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR **41.31** followed by an appeal brief under 37 CFR **41.37**. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in **37 CFR 41.20** have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

***Claim Rejections - 35 USC § 101***

Art Unit: 2132

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 24-26** are rejected under 35 U.S.C. 101 because the subject matter is directed to non-statutory subject matter.

6. **Claims 24-26** are directed to a "machine-readable medium." However, **On paragraph 0070 of applicant's published disclosure, the medium is defined as a "signals on a channel"** which is non-statutory.

On paragraph 0070, the following is recited by the applicant's disclosure.

*"The term "machine-readable medium" refers to any media used to provide information indicative of one or more operational instructions for the machine 500. Such information includes machine instructions provided to the processing system 502 for execution, and such media include memory devices/units, **as well as signals on a channel.**"*

*In view of the above understanding,*

The language of the claims raises a question as to whether the limitation recited as "medium," is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a). Therefore the claim does not fall within the statutory classes listed in 35 USC 101.

7. **Claims 27-28** are directed to a "decoder." However,

Art Unit: 2132

on paragraph 0029 of applicant's published disclosure, the "decoder" is defined as a "software" which is non-statutory.

On paragraph 0029, the following is recited by the applicant's disclosure.

*"The content decoder 100 may be software running on a computer, microprocessor or other machine, or the content decoder 100 may be software and/or hardware in a media-receiving device such as a set-top box the content decoder 100 may be software and/or hardware in a media-receiving device such as a set-top box."*

Furthermore, on paragraph 0060, of the applicant's disclosure the following has been recited.

*"The digital content decoder may be implemented in software, hardware, or a combination of both."*

Furthermore, on paragraph 0018, of the applicant's disclosure the following has been recited.

*"A content decoder (e.g., a media player device such as a Tivo or a Replay device, media player software, or a component of these) can be logically divided into a replaceable decoder core and remaining portions."*

*In view of the above applicant's recitation,*

The language of the claims raises a question as to whether the limitation recited as "decoder," is directed merely to an software/abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a). Therefore the claim does not fall within the statutory classes listed in 35 USC 101.

Art Unit: 2132

8. Claims 29-30 are directed to a "software plug-in means" which is non-statutory. Furthermore, on paragraph 0065 of applicant's published disclosure, the following has been recited.

*"...the process of FIG. 4 may be initiated automatically as part of a larger process, such as **when a software program** automatically retrieves a plug-in for itself..."*

The language of the claims raises a question as to whether the limitation recited in the claim, is directed merely to an software/abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a). Therefore the claim does not fall within the statutory classes listed in 35 USC 101.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by **Fumio Kohno** (hereinafter refereed as **Kohno**) (U.S. Publication No. 2002/0057799) (Filed on October 9, 2001)

Art Unit: 2132

11. **As per independent claims 1 and 14 Kohno discloses a method**  
*[paragraph 0101, 0113 and 0153] comprising:*

- **Transmitting a decoder core [paragraph 0247-0251]**

*("information stored on the storage medium/playback card" is met the "decoder core", on paragraph 0247, the following has been disclosed. "On the storage medium/playback card, information about a condition under which a movie is to be played, information used to manage distribution, and key data (also referred to simply as a key) used to decrypt encrypted content data are stored." Furthermore, on the same paragraphs 0247-0248, these information stored on storage medium/playback card/decoder core **are transmitted/transported or distributed** to the movie theaters 502.) to be used with a predefined content decoder, ["playback apparatus" shown on figure 2, ref. Num "3"]*

- **The decoder core comprising instructions for causing the predefined content decoder to decrypt an encrypted version of digital content.** [Paragraph 0267 and 0262, 0089] *(The playback apparatus 3 content decoder, in each movie theater 502 receives the content data 6 and the associated additional information. The playback apparatus 3 reads the information stored on the delivery card 4. Using a key read from the delivery card 4, the playback apparatus 3 decrypts the encrypted content data and additional information, and plays back the content data in accordance with the additional information read from the delivery card 4. On paragraph 0262, it has been disclosed that as many delivery cards/decoder cores as there are movie theaters/playback apparatus/content decoder is produced and this meets the limitation of "predefined content decoder")*

12. **As per independent claim 24 and dependent claims 25-26 Kohno discloses a machine-readable medium embodying information indicative of instructions for**

Art Unit: 2132

**causing one or more machines to perform operations [paragraph 0101, 0113 and 0153] comprising:**

- **Defining an interface between a presentation portion** [Figure 6, ref. Num “212” and “213” and paragraph 0365 and paragraph 0814] ( “The user control unit 210 is used by a human operator to issue various commands or data to the playback apparatus 3. Under the control of the display controller 212, the display unit 213 displays formation such as the additional information stored in the storage unit 209 so that the human operator can read the information. The display unit 213 also displays an operation guide or various menus.”) **and**

**a decryption portion of a digital content player** [figure 6, ref. Num “203” and paragraph 0452-0453] (Thereafter in step F53, the decryption unit 203 reads, via the card read/write controller 205, the decryption key DK2 generated by the key generator 204 and decrypts the received and demodulated decryption key DK1 using the decryption key DK2. Furthermore, using the decrypted decryption key DK1, the decryption unit 103 decrypts the content data and the additional information.);

**Identifying a decoder core that uses the interface to effect the decryption portion of the digital content player; and using the decoder core with the digital content player to access encrypted digital content.** [0300 and 0344-0345] (When the additional information is read from the delivery card 4, the decryption unit 27 decrypts the encrypted decryption key DK1 stored in the delivery card 4, using the decryption key DK2 managed by the schedule managing unit 26. Using the decryption key DK1 decrypted by the decryption unit 27, it is possible to decrypt the encrypted additional information stored in the delivery card 4. And on paragraph 0344, the following has been disclosed. “More specifically, the card interface 211 gets access to the delivery card 4 returned from the relay server 2 to read the additional information and the decryption key. And on paragraph 0345, the following has been disclosed. “A decryption unit 203



Art Unit: 2132

*decrypts encrypted data such as the encrypted content data and the encrypted additional information obtained via the demodulation performed by the demodulator 202 or decrypts the encrypted additional information or flag read from the delivery card 4 via the card read/write controller 205.”)*

**13. As per independent claims 27, 29 and dependent claims 28 and 30 Kohno discloses a content decoder [paragraph 0175 and figure 6] comprising: a module defining an interface [Figure 6, ref. Num “211”] between the content decoder [figure 6, ref. Num “3”/paragraph 0175] and a mutable decoder core [“figure 6, ref. Num “4”] comprising instructions for causing the content decoder to decrypt encrypted media. [Paragraph 0247-0251 and paragraph 0452-0453, paragraph 0087,]**

*(“Information stored on the storage medium/playback card shown on figure 6, ref. Num “4” is met the “decoder core”, on paragraph 0247, the following has been disclosed. “On the storage medium/playback card, information about a condition under which a movie is to be played, information used to manage distribution, and key data (also referred to simply as a key) used to decrypt encrypted content data are stored.” Furthermore, on the same paragraphs 0247-0248, these information stored on storage medium/playback card/decoder core are transmitted/transported or distributed to the movie theaters 502/playback apparatus shown on figure 2, ref. Num “3” and paragraph 0452-0453, the following has been disclosed. “Thereafter in step F53, the decryption unit 203 reads, via the card read/write controller 205, the decryption key DK2 generated by the key generator 204 and decrypts the received and demodulated decryption key DK1 using the decryption key DK2. Furthermore, using the decrypted decryption key DK1, the decryption unit 103 decrypts the content data and the additional information.” And on paragraph 0087, the following has been disclose. “ Herein, the recording step may record, on the storage medium, an identifier of the data, an allowed reproduction period assigned to the data, and a key used to decrypt the data, and the updating step may update the*

*information recorded on the storage medium" this updating implies that information stored on the storage medium is mutable/changes)*

**14. As per dependent claims 2-4 and 19-20 Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, further comprising receiving a request to access digital content, wherein the transmitting comprises transmitting in response to the request. [Figure 2] (As shown on figure 2, A movie theater/playback apparatus/decoders have to request the movie distribution company before the encrypted content and the delivery card shown on figure 2, ref. Num "4" containing all the information including the decryption key is delivered to them )**

**15. As per dependent claim 5 Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the information comprises a serial number for a session. [Paragraph 0111, "see the an identifier of the data recorded on the storage medium/ delivery card."]**

**16. As per dependent claim 6 Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the information comprises timing information. [Paragraph 0111, "see an allowed production period assigned and recorded on the storage medium/ delivery card." And claim 89]**

**17. As per dependent claim 7-9 and 22-23 Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the decoder core further comprises a decryption key and/or wherein the decoder core comprise software. [Paragraph 0111, see the key used to decrypt the data.]**

Furthermore, on paragraph and see also paragraph 1108-1112 about the claims 8-9 and 22-23 and paragraph 0101, 0113 and 0153] (paragraph 1108, recites the following. The processes performed by the server 1, the relay server 2, and the playback apparatus 3, respectively, may be performed by means of hardware or software. In the case where the

Art Unit: 2132

*processes are performed by means of software, a software program is installed on a computer embedded in special-purpose hardware such as a transmitter/receiver apparatus or a recording/playing back apparatus or is installed on a general-purpose computer. And paragraph 1109 discloses the following. FIG. 55 illustrates an example of a configuration of a computer in which a program used to execute the processes described above is installed. And paragraph 1110 teaches the following. The program may be stored, in advance, on a hard disk 405 serving as a storage medium or in a ROM 403 which are disposed inside the computer. And finally paragraph 1111-1112, discloses the following. Alternatively, the program may be stored (recorded) temporarily or permanently on a removable storage medium 111 such as a floppy disk, a CD-ROM (Compact Disc Read Only Memory), a MO (Magneto-optical) disk, a DVD (Digital Versatile Disc), a magnetic disk, or a semiconductor memory. Such a removable recording medium 411 may be provided in the form of so-called package software. Instead of installing the program from the removable recording medium 411 onto the computer, the program may also be transferred to the computer from a download site via a digital broadcasting satellite by means of radio transmission or via a network such as a LAN (Local Area Network) or the Internet by means of wire communication.)*

**18. As per dependent claims 10-11, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the content-specific obfuscated software corresponds to a content-specific encryption algorithm, the method further [paragraph 0101, 0113 and 0153] comprising:**

**Encrypting the requested digital content using the content-specific encryption algorithm; and Delivering the encrypted digital content. [figure 2, see "transmit encrypted data"];**

Art Unit: 2132

**19. As per dependent claim 12, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the predefined content decoder comprises a previously delivered media player. [See figure 2. ref. Num 3, see "playback apparatus"]**

**20. As per dependent claim 13, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the previously delivered media player comprises a satellite transmission receiving device, and wherein the transmitting a decoder core comprises transmitting the decoder core along with the encrypted version of the digital content from a satellite. [Paragraph 0246-0245 and figure 2] *(The transmission line 7 serving as the communication network may be a public communication network in a wire or wireless form. A private communication line may also be employed as the transmission line 7 for connection between a movie distribution company 501 and a movie theater 502. And on paragraph 0246 the following has been disclosed. "For example, the Internet, a satellite communication network, an optical fiber network, or other various types communication lines can be used.")***

**21. As per dependent claim 15-16, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein receiving a decoder core comprises receiving the encrypted digital content and the decoder core together. [Figure 2, see "transmit encrypted data" and the figure 2, ref. Num "4"]**

**22. As per dependent claim 17, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, further comprising receiving the encrypted digital content separate from the decoder core. [See abstract]**

**23. As per dependent claim 18, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein receiving the**

Art Unit: 2132

**encrypted digital content comprises receiving the encrypted digital content on an optical disc, and the previously acquired content decoder comprises an optical disc playing device.** [figure 2, ref. Num "3", "playback apparatus" and paragraph 0101, 0113 and 015)]

**24. As per dependent claim 21, Kohno discloses a method as applied to claims above. Furthermore, Kohno discloses the method, wherein the information comprises a serial number and timing information, the method further comprising: requesting a signed time check from a server; comparing the signed time check with the timing information; and preventing access to the encrypted digital content if the signed time check does not match the timing information within a predetermined time difference.** [Paragraph 0111, 0113-0114] *(the recording step records an allowed reproduction period during which data corresponding to the key stored on the information storage medium is allowed to be reproduced, and the control step enables or disables the reproduction of the data in the reproducing step, in accordance with the allowed reproduction period recorded on the information storage means.)*

### **Conclusion**

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax

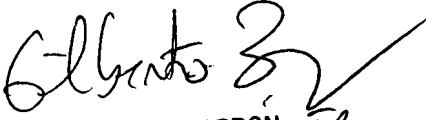
Art Unit: 2132

phone number for the organization where this application or proceeding is assigned is 703-873-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SAMSON LEMMA**

**S.L.**  
**08/02/2007**

  
**GILBERTO BARRON JR**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**